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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/670,559

09/26/2003

Tsuyoshi Kaneko

116945

8128

25944

7590

09/21/2004

OLIFF & BERRIDGE, PLC
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ALEXANDRIA, VA 22320

EXAMINER

NASRI, JAVAID H

ART UNIT

PAPER NUMBER

2839

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/670,559

Applicant(s)

KANEKO, TSUYOSHI

Examiner

Javaid Nasri

Art Unit

2839

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 19-24 and 28-30 is/are rejected.
- 7) ☒ Claim(s) 17, 18 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/26/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

- a) On page 9, Para. [0059], change “26B” to – 26E --.

Note: These are few examples only. Applicant is required to check the entire disclosure and correct the disclosure accordingly.

Claim Objections

2. Claim 18 is objected to because of the following informalities:

- a) In claim 18, “the covering layer” has lack of antecedent base.

Note: These are few examples only. Applicant is required to check all the claims and correct them accordingly.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the

- a) A second convex part per claims 26 and 27,
must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet,

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even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Note: These are few examples only. Applicant is required to check all the drawings and correct them accordingly.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 16, 19-24, 26 and 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Okada et al. (6,065,881).

Okada et al discloses, **for claim 16**, a convex part (21) provided on a substrate (1, 2); and an optical waveguide part (40) provided on the convex part, **for claim 19**, the convex part being

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integrally formed with the substrate, **for claim 20**, a cross-section of the optical waveguide part being in the shape of a truncated oval (see marked figure 8, attached), **for claim 21**, a cross-section of the optical waveguide part being in the shape of a circle (see marked figure 8, attached), **for claim 22**, an upper surface of the convex part being a curved surface (see marked figure 8, attached), **for claim 23**, an angle made between an upper surface of the convex part and a surface that contacts the upper surface on a side part of the convex part being acute (see marked figure 8, attached), **for claim 24**, an upper part of the convex part being formed in an inversely tapered shape (see figure 8), **for claim 26**, a first convex part (21) provided on a substrate (1, 2); an optical waveguide part (40) provided on an upper surface of the first convex part, a second convex part (22, "convex" is interpreted as part of the name) disposed in parallel with the first convex part; and a covering layer (20C, see figure 18B) that covers an optical waveguide part and is provided in part on an upper surface of the second convex part, **for claim 28**, an IC (2); and an optical element, **for claim 29**, an optical waveguide (40), **for claim 30**, an optical module (404).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-15 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al.

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Okada et al discloses all the limitations of claim 26 and all the structural limitations of claims 1-15, as shown above,

However, Okada et al does not disclose:

- a) Two of the second convex part. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have two of the second convex part, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.
- b) In regard to claims 1-15, the claimed method language is counter part of the apparatus claimed. Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to develop a particular method for the disclosed apparatus of the cited references.

Allowable Subject Matter

8. Claims 17, 18 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

REASONS FOR ALLOWANCE

9. The following is an examiner's statement of reasons for allowance:

The reason for allowance of the claims is the inclusion of the limitation,

- a) **For claim 17**, none of the prior art teaches or suggest, alone or in combination the convex part having a lower refractive index than the optical waveguide part, in combination with other limitations in the claim which is not found in the prior art reference of record.
- b) **For claim 18**, none of the prior art teaches or suggest, alone or in combination, the refractive index of the convex part and the refractive index of the covering layer are approximately equal, in combination with other limitations in the claim which is not found in the prior art reference of record.
- c) **For claim 25**, none of the prior art teaches or suggest, alone or in combination, the optical waveguide being buried under a layer with a lower refractive index than the optical waveguide part, in combination with other limitations in the claim which is not found in the prior art reference of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Contact

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javaid Nasri whose telephone number is 571 272 2095. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tulsidas C. Patel can be reached on 571 272 2800 ext 39. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any correspondence to this action may be mailed to:

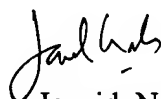
**Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450**

For additional information regarding this new address, which was effective May 1, 2003, see *Correspondence with the United States Patent and Trademark Office*, 68 Fed. Reg. 14332 (March 25, 2003).

Or faxed to: 703-308-7722 or 308-7724 (informal or draft communications should be clearly labeled "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

**Crystal Plaza 4, Fourth Floor (receptionist)
2201 South Clark Place, Arlington, Virginia**


Javaid Nasri

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Primary Examiner
Art Unit 2839

JN

jhn

September 14, 2004